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EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2624

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Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Response to Amendment

1. The amendment filed on 05 July 2005 has been entered in full.
2. Based on the applicant's amendment, the objections to claims 21 and 22 have been withdrawn.

Response to Arguments

3. Applicant's arguments filed 05 July 2005 have been fully considered but they are not persuasive.

Applicant argues, on pages 8 and 9 of the remarks, that:

Gacek does not provide a notification of the amount of data printed but rather focuses on the number of pages that have been printed.

- a. A page of information is an amount of data. Therefore, the amount of pages printed would indicate an amount of data printed.

Gacek does not allow for calculation of specific amounts of data and the resulting specific amounts of ink and paper used.

- b. A page of information is a specific amount of data. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a calculation based on the specific amount of ink and paper used) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The server of Gacek performs the calculation, not the printer.

c. Yeung et al. was combined to teach the calculation occurring with the printer. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Yeung et al. do not teach an amount of data.

d. A page of information is an amount of data. Therefore, the amount of pages printed would indicate an amount of data printed.

It is not obvious to combine a set top box with the functionality of a printer.

e. As priorly stated, While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. To support the

examiner's previous statement, the reference Mann et al. US Patent 6,652,174 is cited to demonstrate the obviousness of combining a set top box with the functionality of a printer.

Gacek's teaching of printing new information is not the same as printing updated information.

f. The applicant argues that the new print request could be the same print as was previously printed from a different provider and would not be considered updated. However, the printing information is considered updated whenever it is rewritten onto memory. Whether this is unique or identical data from what was previously stored, the data is considered updated.

Kolls does not notifying a server an amount of information.

g. Yeung et al. was combined to teach notifying a server an amount of information. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 8-10, 13, 14, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable by Gacek U.S. Patent 6,795,205 and Yeung et al. U.S. Patent 6,690,481.

Referring to claim 1, Gacek discloses an information providing system comprising: a printer (printer 324 of Fig. 3); a user terminal (STB 322 of Fig. 3) connected to said printer and sending print information to said printer (col.15, lines 53-62); and an information providing server delivering information via a communication line (3rd party merchant, col. 9, lines 28-32), wherein said printer comprises: means for acquiring the information delivered from said information providing server, said means for acquiring the information being connected to said information providing server via the communication line (STB 322 of Fig. 3, col. 9, lines 49-53); means for printing the acquired information according to a print instruction received from said user terminal (col. 15, lines 58-62), wherein said user terminal comprises: means for sending a print instruction to said printer (col.15, lines 58-62); and means for setting a print format of the information (col.8, lines 52-58), which is acquired from said information providing server (col. 15, lines 27-33), in said printer, and wherein said information providing server comprises: means for calculating a total of the amount of information (col. 13,

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lines 6-16). Gacek does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose means for notifying an amount of information acquired from said information providing server and printed (col. 12, lines 39-56). Gacek discloses that the print format of the information is set from the preference directory within CHE 6. While the method of obtaining the preferences is not given, Gacek discloses that the user provides these preferences to the CHE 6 (col. 13, lines 46-51), but not how this information is obtained. It would be well known and obvious for the user to enter this information through the Set Top Box. The suggestion for doing so would have been to provide an easy way to provide the user preferences without the requirement of using a phone or mail service. While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The calculation disclosed by Gacek does not disclose expressly calculating the amount of data indicated by the printer. It would have been obvious for the calculation to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Gacek and Yeung et al. are combinable because they are from the same field of communication between elements within a static presentation system. At

the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 2, Gacek discloses the information providing system as defined by claim 1 wherein said printer prints the information when the information is acquired from said information providing server (S615 in Fig. 6B, col. 15, lines 55-58).

Referring to claim 3, Gacek discloses the information providing system as defined by claim 1 wherein said printer prints the information when the information acquired from said information providing server is updated from the information acquired last (col. 12, lines 61-67). The print job disclosed by Gacek is considered updated information when the print job differs and contains new data then the last print job received.

Referring to claim 8, Gacek discloses the information providing system as defined by claim 1 wherein the communication line is a line connected to the Internet (internet 301, Fig. 3).

Referring to claim 9, see claim 1 as needed. Gacek discloses an information providing method comprising the steps of: (a) storing, by an information provider, information into an information providing server (col. 9, lines 28-32); (b) by a printer of a customer, acquiring the information stored in said information providing server (S601-S604, Fig. 6A), printing the information on a print medium (col. 15, lines 55-58); and (c) paying consideration to the customer by the information provider (col. 13, lines 11-16).

Gacek does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose by a printer of a customer, notifying an amount of the printed information to said information providing server (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The calculation disclosed by Gacek does not disclose expressly calculating the amount of data indicated by the printer. It would have been obvious for the calculation to be based on based on the notified amount of information by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Gacek and Yeung et al. are combinable because they are from the same field of communication between elements within a static presentation system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 10, Gacek discloses the information providing method as defined by claim 9 wherein said information providing server and said printer are connected via the Internet (internet 301, Fig. 3).

Referring to claim 13, see above claims as needed. Gacek discloses an information providing system comprising: an information providing server having means for storing information to be provided to customers (col. 9, lines 28-32); means for setting a printer at a customer so as to acquire the information stored in said information providing server (S601-S604, Fig. 6A), to print the information (col. 15, lines 55-58); wherein said information providing server comprising means for paying the customer by an information provider (col. 13, lines 11-16). Gacek does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose means to notify an amount of the printed information to said information providing server (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The calculation disclosed by Gacek does not disclose expressly calculating the amount of data indicated by the printer. It would have been obvious for the calculation to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Gacek and Yeung et al. are combinable because they are from the same field of communication between elements within a static presentation system. At the time of the invention, it

would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 14, Gacek discloses the information providing system as defined by claim 13 wherein said information providing server and said printer are connected via an Internet (internet 301, Fig. 3).

Referring to claim 18, see above claims as needed. Gacek discloses a computer readable program product for performing an information providing service (col. 22, lines 13-22), the program product comprising the steps of; (a) storing information to be provided to customers in an information providing server (col. 9, lines 28-32); (b) setting a printer at a customer so as to acquire the information stored in said information providing server (S601-S604, Fig. 6A), to print the information (col. 15, lines 55-58); (c) paying the customer (col. 13, lines 11-16). Gacek does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose notifying an amount of the printed information to said information providing server (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The calculation disclosed by Gacek does not disclose expressly calculating

the amount of data indicated by the printer. It would have been obvious for the calculation to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Gacek and Yeung et al. are combinable because they are from the same field of communication between elements within a static presentation system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 21, see above claims as needed. Gacek discloses a printer (printer 324 of Fig. 3) connectable to a user terminal (STB 322 of Fig. 3) which receives information from an information providing server (3rd party merchant, col. 9, lines 28-32) via a communication line and sends said information to the printer with a print instruction (col.15, lines 53-62) and sets a print format for the information (col.8, lines 52-58), and wherein the information providing server can calculate a total of the amount of information (col. 13, lines 11-16), said printer comprising: means for acquiring the information delivered from said information providing server, said means for acquiring the information being connected to said information providing server via the communication line (STB 322 of Fig. 3, col. 9, lines 49-53); means for printing the acquired information according to a print instruction received from said user terminal

(col. 15, lines 58-62); and means for notifying an amount of information acquired from said information providing server and printed (col. 13, lines 11-16). Gacek does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose means for notifying an amount of information acquired from said information providing server and printed (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The calculation disclosed by Gacek does not disclose expressly calculating the amount of data indicated by the printer. It would have been obvious for the calculation to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Gacek and Yeung et al. are combinable because they are from the same field of communication between elements within a static presentation system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 22, see above claims as needed. Gacek discloses a printer (printer 324 of Fig. 3) connectable to a user terminal (STB 322 of Fig. 3) which receives information from an information providing server (3rd party merchant, col. 9, lines 28-32) via a communication line and sends said information to the printer with a print instruction (col.15, lines 58-62) and sets a print format for the information (col.8, lines 52-58), and wherein the information providing server can calculate a total of the amount of information (col. 13, lines 11-16), said printer comprising: a printhead which prints the acquired information according to a print instruction received from said user terminal (col. 15, lines 58-62); and an information processor which acquires information delivered from said information providing server via the communication line (STB 322 of Fig. 3, col. 9, lines 49-53), and which provides notification of an amount of information acquired from said information providing server and printed (col. 13, lines 11-16). Gacek discloses that the print format of the information is set from the preference directory within CHE 6. While the method of obtaining the preferences is not given, Gacek discloses that the user provides these preferences to the CHE 6 (col. 13, lines 46-51), but not how this information is obtained. It would be well known and obvious for the user to enter this information through the Set Top Box. The suggestion for doing so would have been to provide an easy way to provide the user preferences without the requirement of using a phone or mail service. Official Notice is taken that it is well known and conventional for a printer to include a printhead and a processor (see MPEP 2144.03). A printhead and processor are standard components in common printers and the printer disclosed by Gacek is a generic printer. The suggestion for using a

printhead is its function for making contact with the paper and applying the ink or toner to the page. The suggestion for using a processor is its function for controlling the operation of the printhead in printing a document. Gacek does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose means for notifying an amount of information acquired from said information providing server and printed (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The calculation disclosed by Gacek does not disclose expressly calculating the amount of data indicated by the printer. It would have been obvious for the calculation to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Gacek and Yeung et al. are combinable because they are from the same field of communication between elements within a static presentation system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

5. Claims 1, 11, 12, 15-17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S. Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481.

Referring to claim 1, Kolls discloses an information providing system comprising: a printer (printer 104 of Fig. 1); a user terminal (system 500, col. 7, lines 6-30) connected to said printer and sending print information to said printer (block 1408 of Fig. 16, col. 36, lines 34-37); and an information providing server delivering information via a communication line (universal server, col. 13, lines 19-40), wherein said printer comprises: means for acquiring the information delivered from said information providing server, said means for acquiring the information being connected to said information providing server via the communication line (modem control means 512, col. 41, lines 57-63); means for printing the acquired information according to a print instruction received from said user terminal (col. 41, lines 24-28), wherein said user terminal comprises: means for sending a print instruction to said printer (col. 41, lines 24-28); and means for setting a print format of the information, which is acquired from said information providing server (col. 41, lines 57-63), in said printer, and wherein said information providing server comprises: means for calculating a total of the amount of information (block 1504, col. 36, lines 62-66). The coupon data disclosed by Kolls can include data accessible by system 500 (col. 41, lines 57-63). With modem control means 512, coupon data can consist of information from the server. Kolls discloses that printed data can consist of information obtained from PC 630 (col. 35, lines 60-66). By using a computer, the user can control the print format of the information. Kolls

what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 11, Kolls discloses an information providing method comprising the steps of: (a) storing, by an information provider, information into an information providing server (col. 41, lines 57-63); (b) lending printer from the information provider to a customer (col. 17, lines 42-55); (c) by said Printer, acquiring the information stored in said information providing server (block 1408, col. 36, lines 33-35), printing the information on a print medium (col. 36, lines 46-50); and (d) collecting, by the information provider, an amount of value corresponding to a rental charge of said printer from the customer (block 1504, col. 36, lines 62-64). Kolls does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose the step of by said printer, notifying an amount of the printed information to said information providing server (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The collection disclosed by Kolls does not disclose expressly being based on the amount of data indicated by the printer. It would have been obvious for the collection to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing

discloses a generic printer and does not disclose expressly the components within the printer. It is well known and conventional for a printer to be physically connected to a computer and a server via a communication line. The suggestion for doing so would have been for the printer to receive the information that it is printing. Kolls does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose the means for notifying an amount of information acquired from said information providing server and printed (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The collection disclosed by Kolls does not disclose expressly being based on the amount of data indicated by the printer. It would have been obvious for the collection to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Kolls and Yeung et al. are combinable because they are from the same field of internet document delivery printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only

documents and not charge or reward for documents that are sent but not printed due to error. Kolls and Yeung et al. are combinable because they are from the same field of internet document delivery printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 12, Kolls discloses the information providing method as defined by claim 11 wherein said information providing server and said printer are connected via the Internet (col. 6, lines 29-32).

Referring to claim 15, Kolls discloses an information providing system comprising: an information Providing server having means for storing, by an information provider, information to be provided to customers (col. 41, lines 57-63); means for registering a printer lent from the information provider to a customer (col. 17, lines 42-55); means for setting said printer so as to acquire the information stored in said information providing server (block 1408, col. 36, lines 33-35), to print the acquired information (col. 36, lines 46-50); and means for collecting a rental charge of said printer from the customer (block 1504, col. 36, lines 62-64). Kolls does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose means to notify an amount of the printed information to said information providing server (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically

separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The collection disclosed by Kolls does not disclose expressly being based on the amount of data indicated by the printer. It would have been obvious for the collection to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Kolls and Yeung et al. are combinable because they are from the same field of internet document delivery printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 16, Kolls discloses the information providing system as defined by claim 15 wherein said information providing server and said printer are connected via an Internet (col. 6, lines 29-32).

Referring to claim 17, Kolls discloses the information providing system as defined by claim 15, wherein said means for setting the printer includes a program which performs said setting through being accessed by said printer (col. 5, lines 2-4).

Referring to claim 19, Kolls discloses a computer readable program product for performing an information providing service (col. 5, lines 2-4), the program product

comprising the steps of; (a) storing information to be provided to customers in an information providing server (col. 41, lines 57-63); (b) registering a printer lent from an information provider to a customer (col. 17, lines 42-55); (c) setting said printer so as to acquire the information stored in said information providing server (block 1408, col. 36, lines 33-35), to print the acquired information (col. 36, lines 46-50); and (d) collecting an amount of value corresponding to a rental charge of said printer from the customer (block 1504, col. 36, lines 62-64). Kolls does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose the step of notifying an amount of the printed information to said information providing server (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The collection disclosed by Kolls does not disclose expressly being based on the amount of data indicated by the printer. It would have been obvious for the collection to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Kolls and Yeung et al. are combinable because they are from the same field of internet document delivery printing systems. At the time of the invention, it would have been obvious to a person of

ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 20, Kolls discloses the program product as defined by claim 19, wherein said amount of value corresponds to a rental charge less an amount associated with the notified amount of the printer information (col. 40, lines 36-41).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S. Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481, as applied to claim 1 above, and further in view of Massarsky U.S. Patent 6,718,123.

Kolls discloses the information providing system as defined by claim 1 wherein, when said printer prints the information received from said user terminal, said printer prints the information, which is acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing in the print margin. Massarsky discloses inserting advertisements onto printed photographs at photo-booths (col. 6, lines 49- 56). The location of the advertisement is shown as with the print margin (Fig. 5A). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to insert the advertisements into internet based data as disclosed by Kolls into the print margin as disclosed by Massarsky. One of ordinary skill in the art would have been motivated to do this to keep the dimensions of the printing area of the internet based data while allowing an advertisement to be inserted into the

printed material and so as to not interfere with the picture being printed since the margin is outside the picture image.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S. Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481 as applied to claim 1 above, and further in view of Massarsky U.S. Patent 6,718,123 and Muramatsu et al. U.S. Patent 5,818,606.

Kolls, Massarsky, and Muramatsu et al. disclose the information providing system as defined by claim 1 wherein, when said printer prints the information received from said user terminal, said printer prints the information, which is acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing in the print margin. Massarsky discloses inserting advertisements onto printed photographs at photo-booths (col. 6, lines 49- 56). The location of the advertisement is shown as with the print margin (Fig. 5A). Massarsky does not expressly disclose reducing the print field of the information to produce a print margin. Muramatsu et al. discloses a printing method of reducing the size of printing material (Fig. 29, col. 22, lines 42-44). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to produce a print margin with the printing method disclosed by Muramatsu, insert an advertisement into printed material as disclosed by Massarsky, and combine coupons with internet based data as disclosed by Kolls. One of ordinary skill in the art would have been motivated to do this to allow a

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greater area for coupons to be inserted into printed internet based data and to make the items being printed better fit into the document without interfering with the picture being printed.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S. Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481 as applied to claim 1 above, and further in view of Freedman U.S. Patent 4,839,829.

Kolls discloses the information providing system as defined by claim 1 wherein, when said printer prints the information received from said user terminal, said printer combines the information acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing in blank portions of the document. Freedman discloses inserting advertisements into blank portions of printed material (col. 10, lines 11-14). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to insert the advertisements into internet based data as disclosed by Kolls into blank portions of printed material as disclosed by Freedman. One of ordinary skill in the art would have been motivated to do this to efficiently allow coupons to be inserted into printed internet based data without wasting paper space.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S. Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481 as applied to claim 1 above, and further in view of DeBruin-Ashton U.S. Patent 6,014,629.

DeBruin-Ashton discloses the information providing system as defined by claim 1 wherein said printer prints the information, which is acquired from said information providing server. Kolls discloses that printed coupon data can consist of financial or other internet based data (col.41, lines 57-63). Kolls does not expressly disclose printing on the reverse side of the document. DeBruin-Ashton discloses inserting advertisements onto the other side of printed material (Fig. 3A and Fig. 3B, col. 13, lines 48-53). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to insert the advertisements into internet based data as disclosed by Kolls onto both sides of printed material as disclosed by DeBruin-Ashton. One of ordinary skill in the art would have been motivated to do this to allow utilizing both sides of a page and eliminate wasted paper space for inserting coupons onto printed internet based data.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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